

REMARKS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 12-21 are pending; Claims 1-11 are canceled; Claims 12-21 are newly added; and no claims are amended herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claims 1, 3, 5, 6, and 8-11 were rejected under 35 U.S.C. § 112, first paragraph; Claims 2 and 9 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1, 2, 4, and 5-11 were rejected under 35 U.S.C. § 102(b) as unpatentable over Wing (U.S. Pat. No. 4,549,535); and Claims 1-7, 10, and 11 were rejected under 35 U.S.C. § 102(b) as anticipated by D'Ewart (U.S. Pat. No. 3,525,887).

Applicants thank Examiner Scheuermann and Primary Examiner Tomai for the interview granted Applicants' representative on February 11, 2004. During the interview, Claims 12-21 were presented for discussion relative to Wing and D'Ewart.

More specifically, as discussed during the interview, new Claim 12 corresponds to the subject matter of canceled Claims 1 and 2, and addresses the outstanding rejection under 35 U.S.C. § 112, first paragraph. Likewise, Claims 12-21 are believed to overcome the outstanding rejection under 35 U.S.C. § 112, second paragraph. It is therefore respectfully requested that these rejections be withdrawn.

With regard to the rejection of Claims 1, 2, 4, and 5-11 under 35 U.S.C. § 102(b) as anticipated by Wing, that rejection is respectfully traversed.

Claim 12 recites, in part, a linear oscillator, wherein the moving part and the amplitude control spindle reciprocate at or near to a resonance frequency of the linear oscillator.

In the past, linear oscillators using no motion direction converting mechanisms to reciprocate the moving part have resulted in high vibration due to inertia force of the moving part.<sup>1</sup> In light of this difficulty, the Applicants developed the present invention, a goal of which is to provide a linear oscillator that provides a low vibration and small noise and that can be easily miniaturized.<sup>2</sup>

Wing relates to a linear motor massager apparatus. One object of Wing is to provide adjustments of frequency and impact force such that a resonance condition can be set up in the body material (i.e., the human body) to induce standing waves in the musculature and/or bony structure within the body.<sup>3</sup> However, Wing does not disclose or suggest that the linear motor massager apparatus itself vibrates at a resonance frequency of the linear oscillator, and the human body cannot reasonably be interpreted to be a part of the linear oscillator of Wing.

Accordingly, it is respectfully submitted that Wing fails to disclose or suggest that the moving part and the amplitude control spindle reciprocate at or near to a resonance frequency of the linear oscillator, as recited in Claim 12. It is therefore respectfully requested that this rejection be withdrawn.

Regarding the rejection of Claims 1-7, 10, and 11 under 35 U.S.C. § 102(b) as anticipated by D'Ewart, that rejection is also traversed.

The outstanding Office Action relies upon Figure 19 of D'Ewart to show the features recited in newly added Claim 12. However, the Office Action fails to cite to any specific teachings within D'Ewart to support the assertion that the moving part and the amplitude control spindle reciprocate at or near to a resonance frequency of the linear oscillator, as recited in independent Claim 12.

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<sup>1</sup> Specification, page 1.

<sup>2</sup> Id. at page 2.

<sup>3</sup> Wing, col. 1, lines 35-40.

Moreover, Applicants respectfully submit that the description of Figure 19 of D'Ewart does not support the assertion that the moving part and amplitude control spindle of D'Ewart reciprocate at or near to a resonance frequency of the linear oscillator.

During the interview, it was indicated that the resonance frequency characteristics recited in Claim 12 are inherent in D'Ewart. However, as set forth in MPEP § 2112:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

*In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q. 2d 1955, 1957 (Fed. Cir. 1993) (emphasis in original).

Additionally,

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

*In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999).

Moreover, MPEP § 2112 requires that the Examiner provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art.<sup>4</sup>

As the outstanding Office Action fails to set forth any reasoning whatsoever to support the assertion of inherency, it is respectfully submitted that the outstanding Office Action has not satisfied the requirements set forth in MPEP § 2112. It is therefore respectfully requested that this rejection be withdrawn.

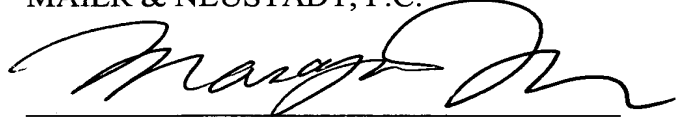
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<sup>4</sup> *Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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